

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

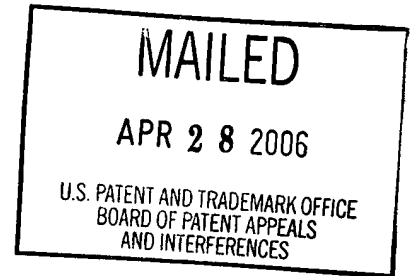
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN TEMPLE
and
PHILIP THOMAS RUMSBY

Appeal No. 2006-1357
Application No. 09/754,486

ON BRIEF



Before KIMLIN, KRATZ, and TIMM, Administrative Patent Judges.

Kimlin, Administrative Patent Judge.

REMAND

This is an appeal from the final rejection of claims 9, 23-25, 31 and 37. The examiner has indicated that claim 34 would be allowable if rewritten to overcome the rejection under § 112, second paragraph, and to include all of the limitations of the base claim and any intervening claims, and that claims 35 and 36 are allowed (see page 10 of answer). We note, however, that prior sections of the answer list claims 34, 35, and 36 in Statements of Rejections.

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The appealed claims stand rejected under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103(a).

In contesting rejections under § 103(a) appellants rely upon an affidavit of one of the inventors, Stephen Temple (see principal brief at page 12, third paragraph, and page 13, second paragraph). Our review of the examiner's answer finds no discussion of the Temple affidavit or any rebuttal of appellants' arguments based thereon. Consequently, the present record is incomplete with respect to the examiner's consideration of all the evidence of obviousness and non-obviousness. Accordingly, this application is remanded to the examiner to afford the examiner the opportunity to place of record his consideration of the Temple affidavit.

Upon return of the application to the examiner, the examiner should consider the acknowledgement at page 1 of the present specification that W093/15911 discloses forming a nozzle in a nozzle plate for an ink jet print head wherein "[t]he divergence of the beam will determine the angle of taper of the nozzle" (page 1 of specification, lines 18-19). It is not clear from the present record that the examiner has considered this apparent acknowledgement of the state of the prior art in determining the obviousness of the claimed subject matter.


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Accordingly, based on the foregoing, the present application is remanded to the examiner.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective Sept. 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Off. Pat. Office 21 (Sept. 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applied if a supplemental examiner's answer is written in response to this remand by the Board.


Edward C. Kimlin)
Administrative Patent Judge)


Peter F. Kratz)
Administrative Patent Judge)


Catherine Timm)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Marshall, Gerstein & Borun, LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, IL 60606

ECK/cam